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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,788	06/15/2001	James K. Hawley	M 6675 MANCO	9982

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EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 03/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,788

Applicant(s)

HAWLEY ET AL. 

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The rejection of Claims 1, 3-10, 12, and 16-17 is maintained from the previous office action under 35 U.S.C. 103(a) as being unpatentable over Sackoff et al. (#4,151,319) in view of Fagan (#4,783,354), Shepherd (#6,025,058), and Aoki et al. (#3,808,091).

Sackoff teaches a synthetic shelf liner (see Abstract) comprising a base layer (Col. 7, line 62 to Col. 8, line 25) having on a first side a layer of polymeric material (Col. 5, lines 10-16; Col. 8, lines 6-14) and having on a second side a layer of adhesive (Fig. 6, #104). The overall thickness of the liner is 1 to 15 mils wherein the adhesive has a thickness in the range of 0.1 to 7 mils and the overall thickness of the laminate is determined by the general end purpose for which it is to be used (Col. 4, lines 1-22). Sackoff teaches that the outer surface of the base layer is treated in such a manner so as to possess or is composed of a material which inherently possesses good release properties relative to the pressure sensitive adhesive material used (Col. 5, lines 10-16). The sheet of synthetic material can be wood, metal foil, paper, or a plastic film, e.g., vinyl polymers, polyolefins such as polypropylene and polyethylene, polyesters, copolymers thereof, or woven or non-woven fabric (Col. 7, line 62 to Col. 8, line 14). The adhesive layer is a pressure sensitive acrylic adhesive (Col. 7, lines 22-23). Sackoff also teaches that the liner does

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not have a release liner such that when the liner is rolled, the adhesive is in contact with the release surface of the base layer (Col. 5, lines 23-31).

Sackoff fails explicitly state that the base substrate is a synthetic paper, although it is notoriously well known in the art that polyethylene, polypropylene, and copolymers thereof, are used to form synthetic paper as evidenced by Aoki et al. (Col. 3, lines 14-20). Sackoff further fails to explicitly state whether the acrylic adhesive is repositionable, that the release layer on the upper surface of the base layer comprises silicone, and the physical properties of the base substrate.

Fagan, however, teaches a shelf liner (see Abstract) wherein the shelf liner comprises a repositionable acrylic adhesive (Col. 2, lines 8-13 and 39-41). Fagan teaches the use of a repositionable acrylic adhesive for the purpose of allowing the user to remove bubbles and wrinkles and to properly match any patterns or designs which appear on the outer side of the base sheet (Col. 7, lines 63-66). It would have been obvious through routine experimentation to one of ordinary skill at the time applicants invention was made to have used a repositionable acrylic adhesive on the backside of a shelf liner for the purpose of allowing the user to remove bubbles and wrinkles and to properly match any patterns or designs which appear on the outer side of the base sheet as taught by Fagan.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Sackoff et al. to include a repositionable acrylic adhesive as taught by Fagan in order to allow the user to remove bubbles and wrinkles and to properly match any patterns or designs which appear on the outer side of the base sheet.

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Shepherd teaches a synthetic paper substrate that can be used for the purpose of providing an alternative to paper wherein durability and toughness are improved (Col. 1, lines 25-27) as well as demonstrating an improved printability over the prior art synthetic papers (Col. 1, lines 37-47; Col. 2, lines 20-22). The synthetic paper comprises a polyolefin film base layer and a surface layer with a silicone polymeric material (Col. 2, lines 23-30). Depending on the desired end product, a pressure sensitive adhesive coating is applied to the surface of the base layer (Col. 4, lines 41-45). The thickness of the base layer is between 10 and 500 micrometers (Col. 3, line 6-8) wherein the film exhibits a tensile strength in the machine direction of 5203 pounds per square inch and 4842 pounds per square inch in the transverse direction (see Table 6). The base primarily comprises a copolymer of polyethylene (see Table 1) (note also that polyethylene and polypropylene are functionally equivalent as demonstrated by Aoki et al. (Col. 3, lines 14-20)). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have used a two-layered synthetic paper substrate for a shelf liner for the purpose of providing an alternative to paper wherein durability and toughness are improved as well as demonstrating an improved printability over the prior art synthetic papers as taught by Shepherd.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Sackoff et al. to include a two-layered synthetic paper substrate as taught by Shepherd in order to provide an alternative to paper wherein durability and toughness are improved as well as demonstrating an improved printability over the prior art synthetic papers.

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3. The rejection of Claims 2, 11, and 13 is maintained from the previous office action under 35 U.S.C. 103(a) as being unpatentable over Sackoff et al. (#4,151,319) in view of Fagan (#4,783,354), Shepherd (#6,025,058), and Aoki et al. (#3,808,091) as applied to claims 1, 3-10, 12-13, and 16-17 above, and further in view of Ito et al. (#4,623,587).

Sackoff et al. fail to teach the use of a polyethyleneimine tie coating between the synthetic paper and the layer of adhesive.

Ito et al., however, teach a multi-layered film material comprising an adhesive layer and a layer of polyethylene and polypropylene copolymers (see Abstract). The film further comprises a polyethyleneimine tie layer between the adhesive and polyolefin base layer for the purpose of increasing the strength of the adhesive bond to the base (Col. 8, lines 3-10). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have used a tie layer between the base layer and adhesive layer of a shelf liner for the purpose of increasing the strength of the adhesive bond to the base as taught by Ito et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Sackoff et al. by adding a tie layer between the base and adhesive layer as taught by Ito et al. in order to increase the strength of the adhesive bond to the base.

4. The rejection of Claims 14-15 is maintained from the previous office action under 35 U.S.C. 103(a) as being unpatentable over Sackoff et al. (#4,151,319) in view of Fagan (#4,783,354), Shepherd (#6,025,058), and Aoki et al. (#3,808,091) as applied to claims 1, 3-10, 12-13, and 16-17 above, and further in view of Warp (#4,947,999).

Although Sackoff et al., Fagan, Shepherd, and Aoki et al. fail to explicitly demonstrate the use of the shelf liners detailed above, it is notoriously well known in the art that the use of a shelf liner would entail the step of adhering the liner to a horizontal surface as demonstrated by Warp (Col. 4, lines 17-28 and 58-61).

Therefore, it would have been obvious at the time applicants invention was made to have modified Sackoff et al. by providing a horizontal surface to adhere the liner to as taught by Warp since it is notoriously well known in the art to provide a horizontal substrate for a shelf liner.

Response to Remarks

5. Applicant's arguments filed December 16, 2002 have been fully considered but they are not persuasive.

First, note that the 35 U.S.C. 112, second paragraph, rejection of "shelf liner" from the previous office action has been withdrawn by the Examiner. The initial rejection was made out of a failure to clearly define "shelf liner" within the specification. The Examiner took the position in the previous office action, and maintains that position, that any article placed on a shelf constitutes a shelf liner (i.e., defined in its broadest possible sense). The Applicant's remarks have clarified and confirmed this position and therefore the Examiner does not require an affidavit on this issue although respectfully thanks the Applicants per their request.

Second, in response to the Applicant's 35 U.S.C. 103(a) argument that there is no suggestion to combine the references of Sackhoff and Aoki, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary

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references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). There is no requirement, however, that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, Sackhoff explicitly states that the sheet of synthetic material can be wood, metal foil, paper, or a plastic film, e.g., vinyl polymers, polyolefins such as polypropylene and polyethylene, polyesters, copolymers thereof, or woven or non-woven fabric (Col. 7, line 62 to Col. 8, line 14). Thus, the teachings of Sackhoff broadly encompass any form of sheet made of the aforementioned materials. Specifically, any sheet made of polyethylene, polypropylene, and copolymers thereof is inclusive within the teachings of Sackhoff. The Examiner then used the teachings of Aoki to demonstrate that polyethylene, polypropylene, or copolymers thereof (Col. 3, lines 14-16) are used in forming synthetic paper. Therefore, under the *McLaughlin* test, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the aforementioned references since taking the two references as a whole suggest to one of ordinary skill in the art that not only can any form of polypropylene, polyethylene, or copolymer thereof be used in the formation of a liner depending on the desired end product, but that inclusive within such materials is synthetic paper.

Finally, in response to Applicant's 35 U.S.C. 103(a) contention that Shepherd teaches away from the Applicant's invention since Shepherd teaches an absorptive property in the disclosed sheet, the limitation on which the Applicant relies (i.e. a sheet material that is less

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absorptive than a fibrous sheet of paper) is not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro Devices, Inc.*, 7 USPQ2d 1064. Furthermore, as noted above, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). The Examiner looked to the teachings of Shepherd to demonstrate the use of a silicone polymeric material on the upper surface of the base layer and the physical properties of the base substrate – whether or not the overall substrate disclosed by Shepherd is absorptive or not is immaterial since taking the teachings of Sackoff et al. and Shepherd as a whole suggest to one of ordinary skill in the art that it would have been obvious to modify the base layer thickness and include a silicone material on the surface of the base layer as taught by Shepherd in order to provide an alternative to paper wherein durability and toughness are improved as well as demonstrating an improved printability over the prior art synthetic papers. The fact that the Applicant's may use the end product for a different purpose does not alter the conclusion that its use in a prior art device would be *prima facie* obvious from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560. It should also be noted that Shepherd teaches an absorptive property in relation to absorbing ink on the surface for writing purposes – there is no evidence that providing a surface absorptive to ink creates the “bubble like protrusions” that are caused by the absorption of water by fibrous paper substrates. Thus, Shepherd does not even necessarily teach away from the current Application.

For the foregoing reasons, the Examiner has maintained all rejections (with the exception of the 35 U.S.C. 112, second paragraph rejection), from the previous office, paper no. 6.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


HAROLD PYON
SUPERVISORY PATENT EXAMINER
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BPE

February 20, 2003

A handwritten signature in black ink, appearing to read "B. M. P. E.", written over the typed name "BPE".